

REMARKS**Foreign Priority**

Applicant respectfully requests the Examiner to acknowledge the claim of foreign priority submitted January 28, 2005 of the instant National Stage Application to Australian Application Nos. 2002950452 and 2002951773.

Information Disclosure Statement

Applicant thanks the Examiner for consideration of the Information Disclosure Statement filed April 18, 2005, and return of an initialed Form PTO-1449.

Applicant notes that the Examiner has stated that the information disclosure statement filed July 30, 2003 is not proper. However, Applicant notes that no such information disclosure statement with that date is present in the file. However, Applicant does note that a PCT Search Report has been made of record wherein the PCT Application has an International Filing Date of July 30, 2003. It is noted that the Search Report is submitted as a regular course of proceeding in the instant National Phase application. Therefore, on the next communication from the USPTO, Applicant respectfully requests the Examiner to clarify why the July 30, 2003 document is not proper.

Drawings

Regarding the drawings, the Office Action contains the following objections:

“identification means” (claim 38) must be shown in the drawings:

Applicant notes that the specification at page 11, line 26 states that the “identification means” is not shown. Applicant respectfully submits that a detailed illustration of the feature is not required if it is not essential for a proper understanding of the invention. (See, e.g., MPEP § 608.02). Therefore, a detailed illustration of “identification means” is not essential for a proper understanding of the invention, as one having ordinary skill in the art would recognize what “identification means” is, as this feature is adequately described in Applicants’ specification.

“upper end 38” recited at p. 8, lines 2 and 10-11 is not shown in the drawings:

Applicant submits herewith a replacement sheet of Fig. 1 which now includes the numeral “38” pointing to the top of thrust member “34”. Applicant has also submitted herewith an annotated sheet showing the changes made to Fig. 1. Applicant submits that no new matter has been added. Therefore, Applicant respectfully requests the Examiner’s acceptance of the replacement sheet for Fig. 1 in the next communication from the USPTO.

Numeral “24” is used to designate both “annular lip” and “locating lip.”

By the present amendment, Applicant has clarified the specification by

changing “locating” to “annular” at page 7, line 16 of the specification. Therefore, Applicants respectfully request withdrawal of the drawing objection.

Objections to the Specification

Regarding the specification, the Office Action contains an objection to the specification because, as noted above with respect to the drawings, numeral “24” is used to designate both “annular lip” and “locating lip.”

As noted above, by the present amendment, Applicant has clarified the specification by changing “locating” to “annular” at page 7, line 16 of the specification. Therefore, Applicant respectfully requests withdrawal of the present objection to the specification.

The Office Action also objects to the title for not being descriptive. To further advance prosecution, Applicant has amended the title as suggested in the Office Action.

Summary of the Amendment

Upon entry of the foregoing amendment, claim 1 has been amended to put the claim in conformance with idiomatic English and U.S. practice. Further, claims 40-42 have been canceled without prejudice, waiver, or disclaimer. Applicant reserves the right to pursue the subject matter of the canceled claims

in a continuing application, if Applicant so chooses, and Applicant does not intend to dedicate any of the canceled subject matter to the public.

Additionally, claims 23-39 currently remain pending. Fig. 1 has been amended to include "upper end 38" wherein Fig. 1 now contains the numeral "38" pointing to the top of thrust member "34". The specification has also been amended to even more clearly recite "annular lip" by changing "locating" to "annular" at page 7, line 16 of the specification.

Summary of the Office Action

In the instant Office Action, claims 40-41 are rejected under 35 U.S.C. § 102(b) as being anticipated by Hendrikx. (EP 1060662, hereinafter "HENDRIKX"). In addition, claims 23-27, 29-34, 38-39, and 42 are rejected under 35 U.S.C. § 103(a) as being unpatentable over HENDRIKX in view of Bucalo (U.S. Pat. No. 5,267,572, hereinafter "BUCALO"). Further, claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over HENDRIKX and BUCALO in view of Molumut et al. (U.S. Pat. No. 3,224,434, hereinafter "MOLUMUT"). Further, claims 35-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over HENDRIKX and BUCALO in view of Ritchey (U.S. Pat. No. 6,145,225, hereinafter "RITCHEY"). Lastly, claim 37 is rejected under 35 U.S.C. § 103(a) as being unpatentable over HENDRIKX, BUCALO, and RITCHEY in view of Black (U.S. Pat. No. 6,239,737, hereinafter "BLACK").

ARGUMENTS

In view of the foregoing amendment and remarks, Applicant submits that it is clear that the rejections should be withdrawn, and respectfully request reconsideration of the outstanding Office Action and allowance of the present application. Specific arguments in response to each of the objections and rejections recited in the Office action are set forth below.

1. Rejections under 35 U.S.C. § 102(b)

Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claims 40-41, as being anticipated by HENDRIKX.

By the present amendment, applicant has cancelled claims 40-42, without prejudice. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection of claims 40-41 over HENDRIKX.

2. Rejections under 35 U.S.C. § 103(a)

Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejections of claims 23-39, and 42.

It is well settled that in order to properly establish a *prima facie* case of obviousness, assuming, *arguendo*, that the rejection is based on a proper combination, the combined teachings must disclose all of the recitations of the rejected claims and the cited document(s) must contain some suggestion or motivation for such combination. Applicants respectfully submit that the

obviousness rejections noted above should be withdrawn, at least because the combination is not proper, and, even assuming, *arguendo*, the combination were proper, the combination still would not disclose all of the recitations of claims 23-39, and 42.

Initially, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection of claim 42, has that claim has been cancelled without prejudice by Applicant.

Applicant notes that the secondary document of BUCALO has been used in all of the rejections under 35 U.S.C. § 103. However, Applicant submits that BUCALO fails to specifically teach “the sample removal means being provided with an amount of sample preparative or preservative” as required by claim 23. BUCALO instead teaches a separate preservative container in which the biopsy instrument is placed after performing the biopsy. In addition, BUCALO also teaches a biopsy instrument that does not go fully through the specimen, whereas the present invention completely pierces the specimen (i.e. animal ear).

Therefore, Applicant respectfully submits that BUCALO's preservative container 26 is not, and cannot be an integral part of the sampling device because it is separate therefrom. Accordingly, since BUCALO does not cure the deficiencies of HENDRIKX, and the combination of HENDRIKX and BUCALO does not disclose or suggest all the recitations of the present claims, then all rejections that rely on the combination of HENDRIKX and BUCALO should be withdrawn.

Regarding the rejection of claim 28 as being rejected over HENDRIKX and BUCALO in view of MOLUMUT, Applicant notes that MOLUMUT does not involve cutting tissue from specimens, and is therefore not properly combinable with HENDRIKX and BUCALO. Instead, MOLUMUT regards cutting the patient to remove tissue to be a disadvantage. (See col. 1, lines 21-23). Further, MOLUMUT's device operates on the principle of a vacuum cleaner, thereby obtaining samples from open body cavities by suction. (See col. 3, lines 21-39). In contrast, the present invention uses a porous material over an inlet or outlet of the (sample) chamber, but does not contain both an inlet and outlet for passage of material as does MOLUMUT.

Therefore, in view of the numerous differences as noted above, Applicant respectfully submits that MOLUMUT is incompatible with the HENDRIKX-BUCALO combination. Thus, the combination of MOLUMUT and the HENDRIKX-BUCALO combination fails to teach or suggest all the recitations of the claimed invention.

Therefore, in view of the above remarks, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103(a) rejections of claims 23-39, and 42 should be withdrawn.

Application is Allowable

Thus, Applicant respectfully submits that each and every pending claim of the present invention meets the requirements for patentability under 35 U.S.C. §§

102 and 103, and respectfully request the Examiner to indicate allowance of each and every pending claim of the present invention.

CONCLUSION

In view of the foregoing, it is submitted that none of the cited documents of record, either taken alone or in any proper combination thereof, anticipates or renders obvious the Applicants' invention, as recited in each of claims 23-42. In addition, the applied documents of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Should there be any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

Respectfully Submitted,
Josef PFISTERHAMMER

A handwritten signature in black ink, appearing to read 'Stephen M. Roylance', written over a horizontal line.

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Figure 1

